

REMARKS

In response to the Office Action dated August 6, 2008, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments. By way of summary, Claims 1-7, 9, and 10 were previously pending and remain pending. New Claims 11-13 have been added.

In the changes made by the current amendment, ~~deletions are shown by strikethrough or~~ enclosure in [[double brackets]], and additions are underlined.

Claims 1-7 and 9-13 Are In Condition for Allowance

Claims 1-7, 9 and 10 presently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of one or more of Tremulis, Burns, Abiuso, and Reynolds. Applicant respectfully disagrees and traverses the rejection for the following reasons.

Claim 1, recites, *inter alia*, an “elongated member permanently positioned within [a] tube... formed of a porous material that becomes saturated with a fluid introduced within said tube.” In clear contrast, Wang teaches a non-porous inner tube containing inner ports disposed within an outer tube containing outer ports. Wang’s catheter is configured to “balance the fluid flow rate (a) by providing a smaller ratio of inner ports to outer ports in the proximal portion than in the distal portion, and/or (b) by providing a shorter average flow distance between the more distal inner and outer ports than between the more proximal inner and outer ports.” Col. 3, ll. 36-42. The Office Action acknowledges that Wang does not disclose the above-recited limitation of Claim 1. However, it contends that replacing the inner tube of Wang with a “porous tube” would involve only the “simple substitution of one equivalent for another.”

In Applicant’s previous response, Applicant argued that the proposed modification would change the principle of operation of the Wang catheter and was thus insufficient to establish a *prima facie* case of obviousness. M.P.E.P. § 2143.01 (“if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious”). As noted in that response, Wang explicitly states that “both of [the disclosed] flow balancing mechanisms” of his invention “depend on providing concentric tubes 32 and 38 in infusion section 60 and on the relative placement of ports 48 and 50 in these tubes.” See,

Wang, Col. 5, ll. 42-46 (emphasis added). Thus, Applicant submits that the relevant “principle of operation” involved in the Wang catheter for achieving a more uniform flow is this relative placement of holes within the inner and outer tubes.

The principle of operation of the Wang catheter can be clearly contrasted with that of the present invention. One non-limiting embodiment of the presently-claimed catheter can be described with reference to Figure 13 of the specification. (In Applicant’s previous response, the catheter described in connection with Figure 6 which does not disclose an “annular space” between tube 52 and tubular membrane 54 was inadvertently referred to as embodying the presently-claimed catheter.) Fluid in catheter 200 enters the infusion section by diffusing longitudinally along porous member 206. However, fluid within porous member 206 does not immediately exit porous member 206 and enter into annular region 208. Instead fluid first saturates the porous member. *“Once the member 206 is saturated, the fluid in the member 206 flows into the region 208 and out of the catheter 200 through the exit holes 204.”* ¶ [0073] (emphasis added). The specification explains how this configuration results in uniform fluid pressure throughout the annular region, enabling the fluid to flow “substantially uniformly through all of the holes 204.” Thus, the “principle of operation” involved in the claimed invention relates to molecular cohesion/ adhesion of fluid within the porous member. This principle enables fluid flowing in the catheter to *first* saturate the porous member by diffusing along its length and to *then* exit the catheter at a rate that is substantially uniform along the length of the infusion section.

In the “Response to Arguments” section of the Office Action, the Examiner states that “Applicant has argued that Wang requires a specific arrangement of inner holes but does not consider that the disclosure of Wang is broad enough to also teach that the outer holes are spaced farther apart in the proximal section and closer together in the distal section, thus changing the average fluid flow distance in the proximal versus distal sections.” As an initial matter, Applicant disagrees with the Examiner’s assertion that Applicant has argued that Wang “requires a specific arrangement of inner holes.” In Applicant’s previous response, Applicant simply noted that Wang’s principle of operation was based on the “relative placement of inner and outer ports.” Moreover, Applicant does not see how the “broader teaching” of Wang referred to by the Examiner changes this analysis. If the Applicant’s understanding of the Examiner’s position is

correct, the Examiner is arguing that Wang's fluid control mechanism could utilize an inner tube with holes at regular intervals and an outer tube in which the spacing of the holes is varied. Applicant notes that the principle of operation in such an embodiment would still depend on the "relative placement of inner and outer ports" to achieve uniform flow. The Examiner's position seems to be that this inner tube with regularly-spaced holes could be replaced with an "equivalent" porous member. Applicant maintains for at least the reasons described above that doing so would dramatically change the principle of operation of the Wang catheter. Indeed, Applicant submits that such a modification would not be suitable for the intended purpose of achieving a more uniform flow. Since fluid would first saturate the porous member, it seems likely that the presence of a greater number of holes in the distal region of the outer tube would actually tend to create higher fluid flow in this region due to the presence of a porous member instead of a tube with distinct exit holes. Moreover, Applicant notes that the Examiner's proposed modification would be inconsistent with newly-added Claim 11 which recites that the plurality of exit holes are uniformly spaced along the length of the tube.

Accordingly, Applicant submits that Claim 1 is allowable. Claims 2-7 and 9-11 are allowable, not only because they depend from Claim 1, but upon their own merit as well. If the present rejection is maintained in the next Office Action, Applicant respectfully requests that the Examiner make explicit the alleged "principles of operation" of both the Wang catheter and the proposed combination.

Applicant also submits that new Claims 12-13 are allowable. Claim 12 recites similar limitations to those of Claim 1 and is allowable at least for the reasons described above in connection with Claim 1. In addition, Claim 12 recites an "annular member disposed near the proximal end of said infusion section and configured to substantially prevent fluid introduced within said tube from entering said infusion section without first passing through said elongated member." None of the cited references disclose or render obvious this limitation.

Related Applications/ Patents of Assignee

In a previous response, Applicant drew the Examiner's attention to the following applications/ patents of the present application's assignee.

Serial Number	Title	Filed
11/364,767 (now issued as U.S. 7,348,711)	CATHETER FOR UNIFORM DELIVERY OF MEDICATION	February 28, 2006
10/420,133	CATHETER FOR UNIFORM DELIVERY OF MEDICATION	April 18, 2003

Applicant notes that issues similar to those discussed in the current Response have been raised during prosecution of these applications, and Applicant assumes the Examiner is continuing to monitor developments in their prosecution.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Curtiss Dosier at (949) 721-7613 (direct line), to resolve such issue promptly.

Application No.: 10/828,923
Filing Date: April 21, 2004

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: _____


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